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JUN - 1 2004

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In re application of Dana Ault-Riche et al. :  
Serial No. : 09/910,120 : DECISION ON PETITION  
Filed : July 18, 2001 :  
Attorney Docket No.: 25885-1751 :  
:

This is in response to applicants' petition, filed April 7, 2004 under 37 CFR 1.144, to withdraw the examiner's restriction requirement.

**BACKGROUND**

Review of the file history shows that the application was filed on July 18, 2001 under 35 U.S.C. 111(a) and claims priority to provisional application 60/219,813, filed July 19, 2000. The application as filed contained claims 1-98. On October 2, 2002 the examiner mailed a restriction requirement dividing the claims into 11 groups and requiring a further election of species should group I be elected. In a response filed December 27, 2002, applicants elected group 1, claims 1-37, 93-95 and newly added claim 99. Applicants further elected oligonucleotides having the formula 5'-E<sub>m</sub>-3' as the species. Claims 34-48, 55-92 and 96-98 were cancelled. Applicants traversed the restriction requirement on grounds similar to those presented in the instant petition. On April 8, 2003 the examiner mailed an Office action wherein the restriction requirement among the 11 groups was maintained, the election of species requirement was withdrawn, and a new election of species requirement was made. Applicants were required to select a capture agent and a specific oligonucleotide for examination. On October 7, 2003, applicants filed a response electing oligonucleotides having the formula 5'-E<sub>m</sub>-3' and capture agents that are antibodies. Applicants traversed the election of species requirement on the ground that all the pending claims read on the elected species. On February 25, 2004 the examiner mailed a first Office action on the merits wherein the restriction requirement was made final.

**DISCUSSION**

With regard to the restriction requirement, applicants request rejoinder of groups I (claims 1-37, 93-95 and 99) and III (claims 49-54). Applicants argue that group I is a subcombination of group III. MPEP 806.05(c)(II) states:

ABsp /Bsp No Restriction

If there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

In this case it appears that the subcombination of elements in claim 1 is essential for patentability, and there is no evidence that the combination of claim 49 is patentable without the details of claim 1. Therefore applicants' argument is persuasive.

With regard to the election of species, applicants argue that all of the pending claims encompass oligonucleotides having an E<sub>m</sub> region. MPEP 806.04(f) states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

Applicants' argument is persuasive because the claims are not drawn to mutually exclusive (patentably distinct) species.

#### DECISION

Applicants' petition is **GRANTED**.

The Office action mailed February 25, 2004 is VACATED.

The application will be forwarded to the examiner for examination of all the pending claims of groups I and III.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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